



Docket No. 4439-4040

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Hirofumi TANI, Tamio KAMIDATE, and Koji MAEHANA

Group Art Unit: TBA

Serial No.: 10/566,861

Examiner: TBA

Filed: January 31, 2006

For: ON-CHIP BIOASSAY METHOD AND KIT

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Information Disclosure Statement is filed in accordance with 37 C.F.R. §§1.56, 1.97 and 1.98. The items listed on Form PTO-1449, a copy of which is enclosed, are made of record to assist the Patent and Trademark Office in its examination of this application. The Examiner is respectfully requested to fully consider the items and to independently ascertain their teaching.

1. ☒ For each of the following items listed on the enclosed copy of Form PTO-1449 that is not in the English language, an English language translation of that item or a portion thereof or a concise explanation of the relevance of that item is enclosed:

Cited Reference 1: Hiroshi Maehana et al., "Hen'i Gensei Busshitsu no On Chip Bioassay ni Okeru Kokandoka," Dai 52 Kai Nihon Bunseki Kagakukai Nenkai Koen Yoshishu, page 127, September 9, 2003. This reference is cited as a "P,X" reference in the International Search Report for PCT/JP2004/001128 from which this application is entering the national phase in the United States.

Cited Reference 2: Hiroshi Maehana et al., "Luciferase Idenshi o Mochiita Hen'I Gensei Shiken no Kokandoka to On Chip Keisoku heno Oyo," CSJ: The Chemical Society of Japan Hokkaido Shibu, 2003 Nen Toki Kenkyu Happyokai Koen Yoshishu, page 52, January 31, 2003. This reference is cited as an "X" reference in the International Search Report for PCT/JP2004/001128 from which this application is entering the national phase in the United States. In addition, the Written Opinion of the International Searching Authority (Form PCT/ISA/237) provides a concise explanation of the relevance of the item (English translation of Form PCT/ISA/237 is attached.)

Cited Reference 3: Hiroshi Maehana et al., "Daichokin Koteika Chip o Mochiita Hen'i Gensei Busshitsu no Bioassay," Dai 64 Kai Bunseki Kagaku Toronkai Koen Yoshishu, page 16, May 10, 2003. This reference is cited as an "X" reference in the International Search Report for PCT/JP2004/001128 from which this application is entering the national phase in the United States. In addition, the Written Opinion of the International Searching Authority (Form PCT/ISA/237) provides a concise explanation of the relevance of the item (English translation of Form PCT/ISA/237 is attached.)

[Please note that the spelling "Maebana" in the International Search Report for PCT/JP2004/001128 is incorrect, and is correctly presented as "Maehana" on the attached Form PTO-1449B.]

2. ☐ For each of the following items listed on the enclosed copy of Form PTO-1449 that is not in the English language, a concise explanation of the relevance of that item is incorporated in the specification of the above-identified application.
3. ☐ Any copy of the items listed on the enclosed copy of Form PTO-1449 that is not enclosed with this Information Disclosure Statement was previously cited by or submitted to the Patent and Trademark Office in application Serial No. _____, filed _____.
4. ☒ No fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with:
- ☐ 37 C.F.R. §1.97(b)(1), within three months of the filing date of a national application other than a CPA; or
- ☐ 37 C.F.R. §1.97(b)(2), within three months of the date of entry into the national stage as set forth in §1.491 in an international application; or
- ☒ 37 C.F.R. §1.97(b)(3), before the mailing date of a first Office action on the merits; or
- ☐ 37 C.F.R. §1.97(b)(4) before the mailing date of a first office action after the filing of an RCE under §1.114.
5. ☐ No fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c), after the period specified in paragraph 4 above but before the mailing date of a final action or a Notice of Allowance (where there has been no prior final action), and is accompanied by one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 9 below.
6. ☐ A fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c), after the period specified in paragraph 4 above but before the mailing date of a final action or a notice of allowance (where there has been no prior final action):
- ☐ A check in the amount of \$180.00 is enclosed in payment of the fee.
- ☐ Charge the fee to Deposit Account No. **13-4500**, Order No. _____. A
DUPLICATE COPY OF THIS SHEET IS ATTACHED.
7. ☐ A fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(d), after the mailing date of a final action or a notice of allowance, whichever comes first, but before payment of the issue fee, and is accompanied by:
- a. one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 9 below; and
- b. the fee due under 37 C.F.R. §1.17(p) which is paid as set forth in paragraph 11 below.

8. ☐ This Information Disclosure Statement is being filed in compliance with:
- a. ☐ 37 C.F.R. §1.313(b)(3) or §1.313(c)(1), after the issue fee has been paid and information cited in this Information Disclosure Statement may render at least one claim unpatentable and is accompanied by the attached Petition To Withdraw Application From Issue and fee pursuant to 37 C.F.R. §1.17(h);
 - b. ☐ 37 C.F.R. §1.313(c)(2) or §1.313(c)(3), after the issue fee has been paid and information cited in this Information Disclosure Statement is to be considered in a Request for Continued Examination (RCE) or a Continuation application upon abandonment of the instant application and is accompanied by the attached Petition To Withdraw Application From Issue and fee pursuant to 37 C.F.R. §1.17(h).
 - c. ☐ The fee due under 37 C.F.R. §§1.17(h) is paid as set forth in paragraph 11 below.
9. ☐ I hereby certify that each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.
10. ☒ This document is accompanied by ☒ a Search Report ☐ Communication which was cited in a corresponding ☒ PCT or ☐ Foreign counterpart application.
- ☒ An English translation of the International Preliminary Report on Patentability is attached herewith.
11. ☐ Charge the fees due under 37 C.F.R. §§1.17(h) and 1.17(p) to Deposit Account No. 13-4500, Order No. _____. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required for this Information Disclosure Statement, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4439-4040. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: June 30, 2006

By: _____

Michael Willis
Michael Willis
Registration No. 53,913

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(212) 415-8700 Telephone
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8. ☐ This Information Disclosure Statement is being filed in compliance with:
- a. ☐ 37 C.F.R. §1.313(b)(3) or §1.313(c)(1), after the issue fee has been paid and information cited in this Information Disclosure Statement may render at least one claim unpatentable and is accompanied by the attached Petition To Withdraw Application From Issue and fee pursuant to 37 C.F.R. §1.17(h);
 - b. ☐ 37 C.F.R. §1.313(c)(2) or §1.313(c)(3), after the issue fee has been paid and information cited in this Information Disclosure Statement is to be considered in a Request for Continued Examination (RCE) or a Continuation application upon abandonment of the instant application and is accompanied by the attached Petition To Withdraw Application From Issue and fee pursuant to 37 C.F.R. §1.17(h).
 - c. ☐ The fee due under 37 C.F.R. §§1.17(h) is paid as set forth in paragraph 11 below.
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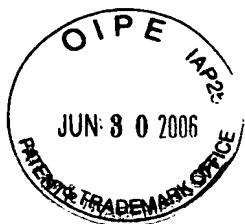
Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

By: Michael Willis
Michael Willis
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Dated: June 30, 2006

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07-03-06

TJW

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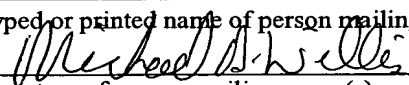
EXPRESS MAIL CERTIFICATE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Express Mail Label No.: EV 825704285 US
Date of Deposit: June 30, 2006

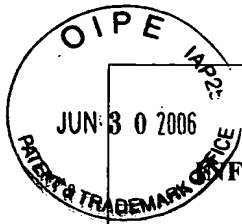
I hereby certify that the following attached paper(s) and/or fee

1. Information Disclosure Statement (3 pages + 1 duplicate)
2. Form 1449B (1 page)
3. 3 Cited References (8 pages)
4. International Preliminary Report On Patentability (5 pages)
5. Return receipt postcard

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Michael A. Willis
(Typed or printed name of person mailing papers(s) and/or fee)

(Signature of person mailing paper(s) and/or fee)

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FORM PTO-1449B

INFORMATION DISCLOSURE
CITATIONAttorney Docket:
4439-4040Serial No.:
10/566,861Applicant:
Tani Hirofumi et alFiling Date:
January 31, 2006Group Art Unit:
TBA

NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.
	1.	Hiroshi Maehana et al., "Hen'i Gensei Busshitsu no On Chip Bioassay ni Okeru Kokandoka," Dai 52 Kai Nihon Bunseki Kagakukai Nenkai Koen Yoshishu, page 127, September 9, 2003.
	2.	Hiroshi Maehana et al., "Luciferase Idenshi o Mochiita Hen'I Gensei Shiken no Kokandoka to On Chip Keisoku heno Oyo," CSJ: The Chemical Society of Japan Hokkaido Shibu, 2003 Nen Toki Kenkyu Happyokai Koen Yoshishu, page 52, January 31, 2003.
	3.	Hiroshi Maehana et al., "Daichokin Koteika Chip o Mochiita Hen'i Gensei Busshitsu no Bioassay," Dai 64 Kai Bunseki Kagaku Toronkai Koen Yoshishu, page 16, May 10, 2003.
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Examiner Signature		Date Considered	
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.